

REMARKS

In response to the Final Office Action dated September 26, 2006, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. A Request for Continued Examination is being filed with this Amendment. Applicants respectfully submit that the claims as presented are in condition for allowance.

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-5, 8-16, and 19-32 were pending in the application, of which Claims 1, 8, and 19 are independent. In the Final Office Action dated September 26, 2006, Claims 1-5, 8-16, and 18-32 were rejected under 35 U.S.C. 103(a). Following this response, Claims 1-5, 8-16, and 19-32 remain in this application. Applicants hereby address the Examiner's rejections in turn.

I. **Rejection of the Claims Under 35 U.S.C. § 103(a)**

In the Final Office Action dated September 26, 2006, the Examiner rejected Claims 1-5, 8-16, and 18-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,711,608 ("*Ogilvie*") in view of Official Notice. Applicants respectfully traverse this rejection, however, to further prosecution, Claims 1, 8, and 19 has been amended. Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

With respect to independent Claims 1, 8, and 19, Applicants respectfully traverse this rejection. The Examiner states that *Ogilvie* does not expressly indicate "notifying a sender that the intended recipient's mail server does not support self-destructing

electronic mail messages.” (See Office Action page 3, lines 15-16.) The Examiner merely takes “Office Notice” that it would be obvious “to provide an [sic] notification that [sic] back to the sender when the mail wasn’t deliver [sic] successfully.” (See Office Action page 3, lines 17-18.)

Applicants respectfully suggest that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teach or suggest every claim limitation. (See MPEP § 2143.) There is nothing in the prior art cited by the Examiner that discloses “notifying a sender that the intended recipient’s mail server does not support self-destructing electronic mail messages”, as recited by Claims 1, 8, and 19, or “removing an email address for the intended recipient whose electronic mail server application does not support self-destructing electronic mail messages,” as recited by Claim 31. (See Office Action page 3, lines 15-16; page 7, lines 8-10.) Accordingly, independent Claims 1, 8, and 19 and dependent Claim 31 each patentably distinguishes the present invention over the cited art, and Applicants respectfully requests withdrawal of this rejection of Claims 1, 8, 18, and 31.

If the Examiner continues to rely on this unsupported contention through “official notice,” Applicants respectfully request the Examiner to provide support. See In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or

principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

Furthermore, amended Claim 1 is patentably distinguishable over the cited art for, at least for the reason that it recites, for example, "determining if the an electronic mail address is located on a network beyond the sender's home domain; canceling the electronic mail message to the intended recipient whose electronic mail address is located on the network beyond the sender's home domain." Amended Claims 8 and 19 each includes a similar recitation. Support for these amendments may be found in the specification at least on page 13, lines 5-10.

Consistent with embodiments of the invention, in the event that an e-mail client application determines that one or more intended recipients is located on a network beyond the sender's home domain, a security warning message may be displayed. (See specification, page 13, line 7-10.) The user may have an option to proceed with sending the self-destructing e-mail message or canceling the e-mail message. (See specification, page 13, line 14-15.) This may allow the user to ensure that a receiving e-mail client application supports self-destructing e-mail messages. (See specification, page 13, line 17-19.)

In contrast, *Ogilvie* at least does not disclose the aforementioned recitation from Claim 1. For example, *Ogilvie* merely discloses network addresses, environmental parameters, and previously sent ID files that are used to determine a message file's present location. (See col. 10, lines 35-39.) If an email connection is available, a packet can be sent to a specified location and the address on the response packet can be examined. (See col. 10, lines 42-44.) Furthermore, *Ogilvie* discloses a message embedded in an executable file being emailed. (See col. 9, lines 21-23.) When the recipient in *Ogilvie* tries to open the message, the executable portion runs an authentication operation to display the message. (See col. 9, lines 23-28.) The message then deletes itself. (See col. 9, lines 28-29.) Because *Ogilvie* discloses a message with embedded with an executable file used to delete itself, *Ogilvie* does not disclose determining if the intended recipient's email address is located beyond the sender's domain and removing the recipient's email address accordingly.

Ogilvie would not have led to the claimed invention because *Ogilvie* at least does not disclose "determining if the an electronic mail address is located on a network beyond the sender's home domain; canceling the electronic mail message to the intended recipient whose electronic mail address is located on the network beyond the sender's home domain," as recited by amended Claim 1. Amended Claims 8 and 19 each includes a similar recitation. Accordingly, independent Claims 1, 8, and 19 each patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claims 1, 8, and 19.

Dependent Claims 2-5, 9-16, and 20-32 are also allowable at least for the reasons described above regarding independent Claims 1, 8, and 19, and by virtue of their respective dependencies upon independent Claims 1, 8, and 19. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 2-5, 9-16, and 20-32.

II. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

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